

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed June 3, 2005. Upon entry of the amendments in this response, claims 6, 8 – 9, 11 – 16 and 21 remain pending. In particular, Applicant has amended claim 21. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

#### **Rejections Under 35 U.S.C. §112**

The Office Action rejects claim 21 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. As set forth above, Applicant has amended claim 21 and respectfully asserts that the rejection has been accommodated.

#### **Rejections Under 35 U.S.C. §103**

The Office Action indicates that claims 6, 8, 9, 11 – 16 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Fu*. Applicant respectfully traverses the rejection.

In this regard, Applicant submits herewith a Declaration under 37 C.F.R. 1.131 in order to swear behind *Fu*. In particular, the Declaration indicates that the invention was conceived prior to 8 March 2001, the critical date of *Fu*. The Declaration also shows that Applicant exercised diligence through the constructive reduction to practice of the invention. That is, the Applicant exercised diligence from a date prior to 8 March 2001 (the critical date of *Fu*) through the filing date of the application (12 March 2001). Additionally, since all activities of the inventor with respect to this invention occurred in the United States, Applicant respectfully asserts that conception and completion of the invention occurred in this country. Applicant respectfully asserts that such showing renders the use of *Fu*

inapplicable for rejecting the pending claims and respectfully requests that the rejection be removed.

Applicant respectfully asserts that the invention disclosure form, a copy of which is attached hereto as Exhibit A of the Declaration Under CFR 1.131, clearly shows that

Applicant conceived the claimed subject matter prior to the critical date of *Fu*. For example,

Applicant respectfully asserts that:

... a document retrieval system communicatively coupled with the intranet, said document retrieval system being configured to receive document reference information corresponding to a document to be printed and printer information corresponding to a network printer and, in response thereto, provide print information corresponding to the document to be printed to the network printer via the Internet such that the network printer prints the document; and

a remote print request system configured to communicatively couple with said document retrieval system, said remote print request system being further configured to receive document reference information corresponding to documents available for printing via the intranet, store the document reference information remotely from the intranet, enable selection by a user of a document to be printed, and provide the document reference information corresponding to a document selected to be printed to said document retrieval system such that the document retrieval system communicates the information corresponding to the document to the network printer without further use of the remote print request system. . .

as recited in independent claim 11 is clearly disclosed on page 3 of Exhibit A.

Additionally, Applicant respectfully asserts that:

...communicatively coupling a personal digital assistant (PDA) to an intranet, the intranet providing access to document reference information corresponding to documents available for printing;

storing the document reference information with the PDA;

retrieving printer information corresponding to a network printer using the PDA, the network printer being configured to communicatively coupled with the intranet via the Internet; and

communicating, from the PDA, the printer information and the document reference information corresponding to a document to be printed such that, responsive thereto, information for printing the document is communicated to the network printer without further use of the PDA, the information for printing the document being communicated to the network printer via the intranet and the Internet with the document being printed at the network printer. . .

as recited in independent claim 21 is clearly disclosed on page 3 of Exhibit A.

Specifically, that page of the invention disclosure form states:

This invention describes a method to do remote Internet printing using an Intranet server. This is accomplished by an Intranet print server that has Internet communication capabilities (such as a proxy server, etc.), *a remote device (such as a PDA) that has references to documents that reside on a company Intranet* and that the Intranet server can access, and a remote printer on the internet that the remote device wants to print to. *The remote device then communicates with the Internet printer and retrieves the information from that printer* that the Intranet print server needs to print. *The remote device then uploads the information about the Internet printer along with the document reference* that it would like to print. *The Intranet server then finds the document on the Intranet that the remote device referenced, establishes communication with the Internet printer that the remote device uploaded information about, and prints the document on that printer* according to its capabilities.

(Invention Disclosure, page 3). (Emphasis added).

Based on the foregoing, Applicants respectfully assert that the inventions as claimed in independent claims 11 and 21 are fully supported by the invention disclosure. In particular, the aspect of the invention as recited in claim 21 involving:

...communicating, from the PDA, the printer information and the document reference information corresponding to a document to be printed such that, responsive thereto, information for printing the document is communicated to the network printer *without further use of the PDA*. . .

(Emphasis added).

is additionally supported by the invention disclosure at page 4. Specifically, that portion of the invention disclosure states:

6) The Intranet server then receives the information, gets the document referenced, sets the options and the destination printer, then sends the document to the remote printer.

(Invention Disclosure, page 4).

Thus, Applicants respectfully assert that the inventions as claimed in independent claim 21 is fully supported by the invention disclosure. The other claims of the application are similarly supported by the attached invention disclosure form.

Additionally, Applicant respectfully asserts that the Declaration clearly demonstrates that Applicant was diligent from a time prior to the critical date of *Fu* through the filing of the application. In particular, the Declaration shows that a copy of the formal declaration for the patent application was provided to the inventor for signature under cover letter of March 8, 2001, and that the inventor reviewed the final draft of the patent application and signed the formal declaration on March 9, 2001. Therefore, Applicant respectfully requests that *Fu* be removed as a reference for rejecting the pending claims and that the claims be placed in condition for allowance.

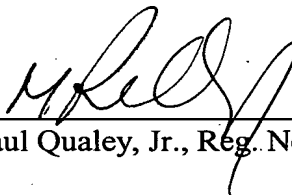
**Cited Art Made of Record**

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

### CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 8/12/05.

Stephanie Riley  
Signature